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10/047,812

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Yasuki Nakajima

4740

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11/17/2006

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EXAMINER

KANG, ROBERT N

ART UNIT

PAPER NUMBER

2625

DATE MAILED: 11/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/047,812

Applicant(s)

NAKAJIMA, YASUKI

Examiner

Robert N. Kang

Art Unit

2625



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 01 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 34-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 34-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Response to Amendment***

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 34-37, 39-45, and 47-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murata (US 2001/0043340) in view of Sawachi (US 6,862,040).

Regarding claims 34 and 42, Murata discloses in paragraph 0092, "a user produces a document or an image using application software... such as a word processor... executed on a personal computer... a memory card to which a print function information file is downloaded is installed in the user's personal computer... The printer driver refers to the print function information file stored in the memory card to display a dialog box for setting the print function of the digital copying machine on the personal computer display."

Murata continues in paragraphs 0095-0096, "if the setting is correct, a print job command file and an image data file are generated to be stored in the memory card... The user pulls out the memory card storing the print job command file and the image data file from the user's personal computer and inserts the memory card into PC card slot 89 (of the printer)... CPU 85 analyzes the print job command file and performs

setting required for the control circuits of the laser part and the sorter part," and prints the job.

Therefore, defining the PC of Murata's invention as the "image processing apparatus," Murata's PC is clearly capable of "detachably mounting thereon a recording medium on which image data are recorded so that an external printer can read out the recorded image data."

Furthermore, the driver generating the print job command file meets the requirement of "a generation means for generating print setting information for printing by the external printer."

Additionally, the driver allows or disallows the selection of various functions based upon the function information file saved in the memory card (paragraphs 0093 and 0095). Therefore, the driver includes an "analyzing means for causing the external printer to read out, from said recording medium, print setting items information indicative of items settable by the external printer and analyzing the read-out print setting item information, when said generating means generates the print setting information, wherein said generating means generates the print setting information on the basis of the print setting item information analyzed by said analyzing means."

Murata does not expressly disclose "the print setting item information indicative of the item settable by the external printer is recorded with respect to a plurality of the external printers," as required by the last limitation of claims 34 and 43.

Sawachi discloses the structure of a "settings memory card 43" in FIG. 3, which includes "a DOS format area, directory area and image recording area... combinations

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of data representing the shooting conditions and image processing methods are recorded in the directory file areas. For example, settings values (which shall be referred to as 'settings values A') are recorded in the directory file area 1" (col. 6, lines 37-46). Examiner notes that several settings directories are depicted in FIG. 3, for corresponding settings A, B... N. Sawachi states in column 3, line 60 to column 4, line 4, "settings data representing shooting conditions of a plurality of types or image processing methods of a plurality of types may be recorded on the settings recording medium. In such case the shooting conditions or image processing methods of the plurality of types represented by the read settings data are displayed on the display unit and a desired shooting condition or processing method is selected from the shooting conditions or image processing methods of the plurality of types displayed on the display unit. Imaging is performed based upon the selected shooting condition and image signal processing is executed in accordance with the selected processing method."

Murata and Sawachi are combinable because they both pertain to automatic image processing based upon settings stored on a removable memory card.

Therefore, it would have been obvious at the time of invention to one of normal skill in the art to include in Murata a method of storing multiple sets of settings on a single card, separated by directories, as taught by Sawachi.

The motivation of this modification would be to allow a user to store multiple printer or digital copier feature sets on a single memory card, such that the "offline

printing" function as disclosed by Murata be applicable to a plurality of external image forming apparatuses, of which the user selects one.

Thus it would have been obvious at the time of invention to combine Murata and Sawachi to obtain the apparatus of claim 34 as well as the method of claim 42.

Regarding claims 35 and 43, Murata's invention generates a print job command file on the removable medium, that, when inserted into a printer, is automatically printed (paragraph 0096). Therefore, the print job command file is "automatic print information describing print image designation information and the print setting information, in order to cause the external to automatically print the image data."

Regarding claims 36 and 44, the Murata/Sawachi combination utilizes a directory file structure as taught by Sawachi and illustrated in FIG. 3, wherein each setting is stored in its own directory. It follows logically that when generating the print job command file, the file is placed in the same directory as the settings which were utilized. However, even if this is untrue, and the print job command file is merely placed outside of the settings directories, it still resides in the "root" directory, separate from the settings. Therefore, regardless of the interpretation of the Murata/Sawachi combination, the "recording medium includes a directory for managing the automatic print information."

In regards to claims 37 and 45, Sawachi depicts in FIG. 3 a different directory for each set of settings in a separate directory from the thumbnail images in the "image recording area". In the context of the Murata/Sawachi combination, each directory stores the specific print function information file for each external printer. Therefore, the combination includes "a directory for managing the print setting information independently of the image data."

Regarding claims 39 and 47, Murata depicts in FIG. 5 the various print settings which may be set in generating the print job command file. Rows 4 and 5 show resolution/grey level settings, which comprise "image processing setting information," while rows 10 and 11 show duplex printing and staple options, which comprise "two-side print setting information and staple setting information."

With regards to claims 40, 41, 48, and 49, Sawachi discloses a display and selection of each set of parameters (col. 3 line 60-col. 4 line 4). In the context of the Murata/Sawachi combination, the display shows several printers, one of which is selected by the user. Thus it includes "a selecting means for selecting the external printer, wherein said generating means generates the print setting information on the basis of the print setting information of the external printer selected by said selecting means."

The method of selecting a printer, as commonly known in the art, may be a printer name, network address, or function (i.e., monochrome, color, stapler, etc.) Since

the Murata/Sawachi combination already expressly teaches saving the functions of a printer on the card, the "setting information describes information for specifying the external printer."

2. Claims 38 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murata (US 2001/0043340) in view of Sawachi (US 6,862,040), further in view of Canon Corporation (reference U).

The Murata/Sawachi system meets the limitations of claims 35 and 43, upon which claims 38 and 46 respectively depend.

Neither Murata nor Sawachi expressly discloses the use of DPOF (Digital Print Order Format) files as the "automatic print data."

Reference U states on page 3, paragraph 2, "in October 1998, four companies including Canon, Fuji Photo Film, Eastman Kodak, and Matsushita Electric Industrial, jointly announced a new standard digital printing format called DPOF (Digital Print Order Format). Therefore, the format was well known in the art to one of normal skill in the art more than one year before the time of invention.

Therefore, it would have been obvious to modify the Murata/Sawachi combination to utilize a DPOF file for the automatic print data.

The motivation behind this modification would be to allow cross platform compatibility, "thereby minimizing cumbersome print ordering processes at the digital service photo-labs as well as for personal printing," as stated in page 3, paragraph 2 of reference U.



Thus, it would have been obvious to modify the Murata/Sawachi combination as disclosed above to utilize DPOF files as taught by reference U to obtain the apparatus of claim 38 as well as the method of claim 46.

**Conclusion**

This rejection is NON-FINAL.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert N. Kang whose telephone number is 571-272-0593. The examiner can normally be reached on M-F 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler M. Lamb can be reached on (571)272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Robert N. Kang



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